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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,629	03/28/2000	Young Jin Oh	43694-5012-2	5666
9629	7590	10/03/2003	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			DUDEK, JAMES A	
			ART UNIT	PAPER NUMBER
			2871	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/536,629	Applicant(s) OH ET AL.	
	Examiner James A. Dudek	Art Unit 2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 29-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/934,770.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: |

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29-33, 35, 39, 43-47, 49 and 53 are rejected under 35 U.S.C. 102(e) as being anticipated by 5870160.

Per claim 29, 160 teaches a liquid crystal display device, comprising: a first substrate [Sub1] including a plurality of data bus lines [DL], a plurality of gate bus lines [GL], and a plurality of thin film transistors at cross points of the plurality of data bus lines and the plurality of gate bus lines [TFT]; a second substrate including a color filter layer [FIL], a liquid crystal layer over the first substrate to apply an electric field to the liquid crystal layer parallel to surfaces of the first and second substrates [see figure 10], and a shielding layer on an outer surface of the second substrate, said shielding layer for shielding an outer electric field [com].

Per claim 43, 160 teaches a method of fabricating a liquid crystal display device, comprising the steps of: forming a plurality of data bus lines and a plurality of gate bus lines on a first substrate; forming a plurality of thin film transistors at cross points of the plurality of data bus lines and the plurality of gate bus lines; forming a shielding layer on an outer surface of a second substrate, said shielding layer for shielding an outer electric field; forming a color filter layer on the second substrate; and forming a liquid crystal layer between the first and second substrates, the liquid crystal layer of the first and second substrates [these method steps are merely generic and thus if the device discloses the structure it inherently teaches the method].

Per claims 30 and 44, 160 teaches the device according to claim 29, wherein said shielding layer includes a transparent conductive metal layer [the conductive material is ITO].

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Per claims 31 and 45, 160 teaches the device according to claim 30, wherein the transparent conductive metal layer includes indium tin oxide.

Per claims 32 and 46, 160 teaches the device according to claim 29, further comprising a pair of electrodes over the first substrate [see figure 10, CL].

Per claims 33 and 47, 160 teaches the device according to claim 32, wherein the pair of electrodes are formed a parallel electric fields of the first and second substrates [see figure 10].

Per claims 35 and 49, 160 teaches the device according to claim 34, wherein the first alignment layer includes a polyimide [see column 11].

Per claims 39 and 53, 160 teaches the device according to claim 34, wherein the second alignment layer includes a polyimide [see column 11].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 34, 36-37, 40-42, 48, 50-52 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over 160.

Per claims 34 and 48, 160 teaches the device according to claim 29, further comprising: a first alignment layer on the passivation layer; and a second alignment layer on the color filter layer. 160 lacks the passivation layer. However it was notoriously well known or common knowledge to use passivation layers on the TFT substrate in order to create a level smooth surface. The layer, therefore, decreases noise. Accordingly, it would have been obvious to one of ordinary skill at the time the invention was made to combine the well known passivation layer with 160.

Per claim 36-38, 40-42, 50-52 and 54-56, 160 teaches the device according to claim 34, but lack the first and second alignment layers includes polyvinylfluorocinnamate or polysiloxane-based materials. First it was well known to use photo-alignment material for orientation layers because no rubbing is involved. Both polyvinylfluorocinnamate or polysiloxane-based where also the common materials for photo-aligned orientation layers because both offer high energy alignment and create an alignment direction with light. Accordingly, it would have been obvious to one of ordinary skill at the time the invention was made to combine the well known polyvinylfluorocinnamate or polysiloxane-based alignment layer with 160.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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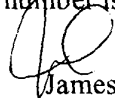
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29-56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6064451. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are broader than the patent claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Dudek whose telephone number is 308-4782. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached on 703-305-3492. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



James A. Dudek
Primary Examiner
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